

## **REMARKS/ARGUMENTS**

Applicants note that the Examiner has maintained the rejection of claims 44 - 56 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,110914.

With this response and filing of a Request for Continued Examination, Applicants amend claims 44 - 49 and 54 and 55 and introduce new claims 57 - 69.

Claims 44 - 69 are now in this application comprising three (3) independent claims and 26 claim in all.

Any additional claim fees are to be charged to deposit account 26-0166.

Claim amendments are submitted merely to correct certain typographical and grammatical errors. new claims are directed to certain classes of compounds within the scope of the description. The amendments and new claims do not introduce any new matter or any matter not supported by the specification as filed.

### **Response to rejections under 35 U.S.C. § 103:**

Applicants respectfully traverse the Examiner's rejection and maintain their position that the Examiner has not established a *prima facie* case of obviousness. Applicants again reiterate their understanding, based on the MPEP, of what the Examiner must show to establish a *prima facie* case of obviousness

Section 2141, **Basic Considerations which Apply to Obviousness Rejections**, states, in part,

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;

(B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and

(D) reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, n.5, 229 USPQ 182, 187, n.5 (Fed.

Cir. 1986)." (MPEP Rev 2, May 2004 p 2100-120/120).

Section 2142, **Legal Concept of *Prima Facie* Obviousness**, states in part, "The Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness." (MPEP Rev 2, May 2004 p 2100-128, first column).

Section 2143, **Basic Requirements of a *Prima Facie* Case of Obviousness**, states, in part,

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

(MPEP Rev 2, May 2004 p 2100-129, second column).

The Examiner has chosen to cite *In re Norris*, 84 USPQ 458 (1950) and *In re Henze*, 85 USPQ 261 (1950) for authority to support the Examiner's opinion that "nothing unobvious is seen in substituting the claimed isomer for the structurally similar isomer", that " the instantly claimed compounds would have been obvious" and "[t]herefore, the instantly claimed compounds would have been suggested to one skilled in the art." Applicants respectfully point out that neither case is cited by the MPEP and that both cases are from an era before the enactment of 35 U.S.C. § 103. Neither case was decided in the light of 35 U.S.C. § 103, nor were they decided in the light of more recent numerous decisions that emphasize that for an invention to be obvious, a suggestion

and a motivation to make the invention must be found either in the references themselves or in the knowledge generally available to those of ordinary skill in the art.

The Examiner states, "RN 220100-73-2 generically teaches the instant claims when, in the instant claims R is hydrogen and C1-4alkyl; and when R1 is -(CH<sub>2</sub>)<sub>n</sub>Ar, Ar is phenyl and n is 0." and, "RN 220100-57-2 generically teaches the instant claims when, in the instant claims R is hydrogen , and C1-4alkyl; and when R1 is -(CH<sub>2</sub>)<sub>n</sub>Ar, Ar is phenyl and n is 0 to 3."

Applicants respectfully point out that the references do not do what the Examiner alleges, RN 220100-73-2 and RN 220100-57-2 each describe a single compound, nothing less, nothing more. Neither reference provides any suggestion or motivation to make anything.

Applicants respectfully point out that the Examiner cites no reference that provides suggestion or motivation to make the instant compounds.

**Conclusion:**

Applicants respectfully request that the Examiner consider the claims submitted herewith in view of the arguments presented above. Applicants solicit prompt issuance of a Notice of Allowability and Notice of Issue Fee Due.

Respectfully submitted,

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